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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,749	10/06/2003	Geoffrey Flagstad	14969US01	2813

23446 7590 08/24/2005

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EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/679,749	Applicant(s) FLAGSTAD, GEOFFREY	
	Examiner Mike Tomaszewski	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20 January 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 6 October 2003. Claims 1-49 are pending. The IDS statement filed 20 January 2004 has been entered and considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 5-8 and 11-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Segal et al. (US 2001/0041991; hereinafter Segal).

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(A) As per Claim 1, Segal discloses a method to obtain a medical record of a patient from a covered entity in a form allowing quick disclosure of said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, comprising:

- (a) inducing said patient to obtain possession of a medical record of said patient from a covered entity (Segal: pg. 2, par. [0014]; pg. 12, par. [0151]) (Examiner notes Segal teaches that the patient has ownership and control of their medical records. As such, other parties interested in acquiring a medical record from a patient would be required to induce the patient to obtain their medical records for them.);
- (b) acquiring said medical record from said patient in a storage format (Segal: pg. 12, par. [0012]); and
- (c) storing said medical record in a memory in a form from which it can be reproduced in said storage format (Segal: pg. 12, par. [0012]).

(B) As per Claim 2, Segal discloses the method of Claim 1, further comprising:

inducing said patient to obtain possession of said medical record in a first format and inducing said patient to convert said medical record to said storage format, wherein said storage format is different from said first format (Segal: pg. 3, par. [0027])

Examiner notes Segal teaches a patient, "with guidance from their physician," obtaining

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their medical record in a first format (i.e., hard copy) and converting said medical record into a storage format (i.e., digital format via computer data entry).

- (C) As per Claim 5, Segal discloses the method of Claim 1, wherein:
said memory is a portable medium (Segal: pg. 12, par. [0151]).
- (D) As per Claim 6, Segal discloses the method of Claim 5, wherein:
said portable medium is an optical disc (Segal: pg. 12, par. [0151]).
- (E) As per Claim 7, Segal discloses the method of Claim 1, further comprising:
retrieving said medical record stored in said memory remotely through a
computer communications network (Segal: Fig. 1).
- (F) As per Claim 8, Segal discloses the method of Claim 1, further comprising:
inducing said patient to update said medical record stored in said memory
(Segal: pg. 12, par. [0151]).
- (G) As per Claim 11, Segal discloses the method of Claim 1, wherein:
said medical record is stored in a hierarchical storage system (Segal: Fig. 2a).
- (H) As per Claim 12, Segal discloses the method of Claim 11, wherein:

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said medical record is assigned to at least one file folder, said file folder containing medical records sharing at least one common attribute (Segal: Fig. 2a).

(I) As per Claim 13, Segal discloses the method of Claim 12, wherein:

said file folder is assigned to at least one file template, said file template containing file folders sharing at least one common attribute (Segal: Fig. 2a).

(J) As per Claim 14, Segal discloses the method of Claim 13, wherein:

a plurality of said file templates are stored in said storage system to form a general medical and personal information file of said patient (Segal: pg. 3, par. [0027]; Fig. 2a).

(K) As per Claim 15, Segal discloses the method of Claim 12, wherein:

said file folder further comprises at least one sub-folder (Segal: Fig. 2a).

(L) As per Claim 16, Segal discloses the method of Claim 11, wherein:

said hierarchical storage system provides hierarchical storage access (Segal: pg. 9, par. [0012]). Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

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(M) As per Claim 17, Segal discloses the method of Claim 14, wherein:

access to a special file template is on a different basis than access to at least one other file template (Segal: pg. 9, par. [0012]). Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

(N) As per Claim 18, Segal discloses the method of Claim 7, wherein:

said special file template is an emergency file template (Segal: Fig. 2a).

(O) As per Claim 22, Segal discloses the method of Claim 20, wherein:

said system is provided in the form of software (Segal: pg. 3, par. [0022]).

(P) Claims 19-21 and 23-29 substantially repeat the same limitations of claims 1, 2, 5-11 and 16, and are therefore, rejected for the same reasons given for those claims.

(Q) Claim 30 differs from method claim 1 and 2 by reciting hardware elements, namely "a communication interface: and "a data storage device." As per these elements, Segal teaches the use of several databases (i.e., data storage devices) and graphical user interfaces (GUIs) (Segal: pg. 3, par. [0022]; Fig. 1). The remainder of system claim 30 repeats the same limitations of method claims 1 and 2, and is

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therefore, rejected for the same reasons given above for claims 1 and 2, and incorporated herein.

(R) As per Claim 32, Segal discloses the system of Claim 30, wherein:

said communication interface is adapted for acquiring said medical record from said patient in said storage format (Segal: pg. 7, par. [0099]; pg. 12, par. [0146]; Fig. 1 and Fig. 4).

(S) As per Claim 46, Segal discloses the system of Claim 44, wherein:

said special file template is stored in a first memory and said general medical information file is stored in a second memory wherein said first and second memories are different optical discs (Segal: pg. 4, par. [0030]; Fig. 1).

(T) Claims 31, 33-45 and 47-49 substantially repeat the same limitations of claims 3-7, 8-18 and 20, and are therefore, rejected for the same reasons given for those claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal as applied to claim 1 above, and further in view of Judson et al. (US 2005/0026117; hereinafter Judson).

(A) As per Claim 3, Segal discloses the method of Claim 1, further comprising:
obtaining the agreement of said patient to allow transmission of said medical record to a health care provider (Segal: pg. 3, par. [0028]).

Segal, however, fails to expressly disclose the method of Claim 1, further comprising:

under defined conditions.

Nevertheless, this feature is old and well known in the art, as evidenced by Judson. In particular, Judson discloses the method of claim 1, further comprising:

under defined conditions (Judson: pg. 8, par. [0105]).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned feature of Judson within the Segal system with the motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) (Judson: pg. 1, par. [0010]).

(B) As per Claim 4, Segal fails to expressly disclose the method of Claim 3, wherein:
said agreement is obtained before a defined condition arises.

Nevertheless, this feature is old and well known in the art, as evidenced by
Judson. In particular, Judson discloses the method of claim 3, further comprising:

said agreement is obtained before a defined condition arises (Judson: pg. 8, par.
[0105]).

One of ordinary skill would have found it obvious at the time of the invention to
include the aforementioned feature of Judson within the Segal system with the
motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) and
decreasing unauthorized access to medical data (Judson: pg. 1, par. [0010] and pg. 8,
par. [0105]).

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Segal as applied to claim 1 above, and further in view of Mok et al. (US 2003/0140044;
hereinafter Mok).

(A) As per Claim 9, Segal fails to expressly disclose the method of Claim 1, further
comprising:

inducing said patient to provide other information that is not a medical record,
and storing said other information in said memory.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok.

In particular, Mok discloses the method of claim 1, further comprising:

inducing said patient to provide other information that is not a medical record, and storing said other information in said memory (Mok: pg. 14, par. [0127]).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned feature of Mok within the Segal system with the motivation of including other types of records where a person needs his/her records collected (Mok: pg. 14, par. [0127]).

(B) As per Claim 10, Segal fails to expressly disclose the method of Claim 9, wherein:

said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok. In particular, Mok discloses the method of Claim 9, wherein:

said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement (Mok: pg. 14, par. [0127]) (The Examiner has noted insofar as claim 10 recites "selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement," an investment portfolio has been recited.).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned feature of Mok within the Segal system with the motivation

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of including other types of records where a person needs his/her records collected

(Mok: pg. 14, par. [0127]).

Condition

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches an all care health management system (5,301,105); an apparatus and method for processing and/or for providing healthcare information and/or healthcare-related information (6,283,761); a system and method for electronic medical record keeping (US 2003/0115084); and a method of and system for controlling access to personal information records (US 2004/0111622).

The cited but not applied prior art also includes non-patent literature articles by Barbara Bowers ("For Your Eyes Only" Apr. 2003. Best's Review. pg. 37) and Christopher Snowbeck ("In Their Own Words Many Patients Begin Keeping Their Own Medical Histories" Aug. 13, 2002. Pittsburgh Post - Gazette. pg. X.1.).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT

MT 8-22-05


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